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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	O	ATTORNEY DOCKET NO.
09/117,838	08/12/98	EPHSTEIN		

HM22/0322

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EXAMINER	
OWENS	

ART UNIT	PAPER NUMBER
1803	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/117,838	Applicant(s) Ephstein
	Examiner Howard Owens	Group Art Unit 1623

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-4* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-4* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Objections

The use of underlined words and parentheses in all occurrences is improper. Appropriate correction is required.

Specification

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated below.

(a) Title of the Invention.
(b) Cross-References to Related Applications (if any).
© Statement as to rights to inventions made under Federally-sponsored research and development (if any).
(d) Background of the invention.
1. Field of the Invention.
2. Description of the Related Art including information disclosed under 37 C.F.R. §§ 1.97-1.99.
(e) Summary of the Invention.
(f) Brief Description of the Drawing.
(g) Description of the Preferred Embodiment(s).
(h) Claim(s).
(I) Abstract of the Disclosure.

The content of the specification does not conform with to the preferred content of a patent application for prosecution in front of the United States Patent and Trademark Office. The following guidelines illustrate the preferred content for patent applications. These guidelines are suggested for the applicant's use.

Content of Specification

(a) Title of the Invention. (See 37 C.F.R. § 1.72(a)). The title of the invention should be placed at the top

of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.

(b) Cross-References to Related Applications: See 37 C.F.R. § 1.78 and section 201.11 of the M.P.E.P.

© Statement as to rights to inventions made under Federally sponsored research and development (if any): See section 310 of the M.P.E.P.

(d) Background of the Invention: The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field".

(2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art".

(e) Summary: A brief summary or general statement of the invention as set forth in 37 C.F.R. § 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(f) Brief Description of the Drawing(s): A reference to and brief description of the drawing(s) as set forth in 37 C.F.R. § 1.74.

(g) Description of the Preferred Embodiment(s): A description of the preferred embodiment(s) of the invention as required in 37 C.F.R. § 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled "Best Mode for

Carrying Out the Invention". Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(h) Claim(s) (See 37 C.F.R. § 1.75): A claim may be typed with the various elements subdivided in paragraph form. There may be plural indentations to further segregate subcombinations or related steps.

(I) Abstract: A brief narrative of the disclosure as a whole in a single paragraph of 250 words or less.

The specification improperly contains the Russian language. The content of all applications for U.S. patents should appropriately use the English language.

Abstract of the disclosure, Content

Applicant is reminded of the proper content of an Abstract of the Disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

Abstract of the Disclosure, Chemical Cases

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts, compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary. Complete revision of the content of the abstract is required on a separate sheet.

Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

Minor informalities

The disclosure is objected to because of the following informalities: The pages contained within the instant specification are not numbered. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-4 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant sets forth in claim 1 "a medicinal preparation comprising material carrier with information on bioactive substance wherein said information is transferred bioenergetically from potentiated medicinal preparation with a chemical formula identical with that of the active medicinal substance".

It is unclear as to how a compound that has the "identical" chemical formula as the active substance can be differentiated from the active substance and is not the active substance itself as products of identical chemical composition can not have mutually exclusive properties. Furthermore, since applicant has not set forth what "information" embodies in full, clear and exact terms, a method or process of producing this "information" also remains vague and indefinite, as well as the proposed method of "transferring" this "information bioenergetically".

The instant specification invites the skilled artisan to experiment. The factors which must be considered in determining undue experimentation are set forth in In re Wands 8USPQ 2d 1400. The factors include:

1) quantity of experimentation necessary,
2) the amount of guidance presented,
3) the presence or absence of working examples,
4) the nature of the invention,
5) the state of the prior art,
6) the predictability of the art,
7) breath of the claims and the
8) level of skill in the art.

(1-3) Quantity of experimentation necessary, Amount of guidance presented, Presence or absence of working examples

Applicant has not set forth any sufficient evidence that would lead one of skill in the art to ascertain not only the nature of the invention with regards to "information" but how one of skill in the art would make this "information" for subsequent transfer. Applicant's working examples are drawn to a method of transferring the information via current conducting plates. Since there is no definition in the instant specification as to what constitutes information and the supposed transfer occurs between two identical compounds, one of skill in the art would be left to undue experimentation in determining not only what has been transferred but how this transfer has actually occurred given that when two compounds are the same, in actuality there is only one compound present. Thus there could be no analytical data or frame of reference which would verify or support that a transfer of any property of matter occurred given that the compositions or compounds contain identical chemical compositions and states of matter.

Nature of the Invention

The invention is drawn to a medicinal composition wherein the components are two identical compounds, in short one compound, and a material carrier; wherein the formation of the composition occurs through a "bioenergetic transfer of information".

Predictability of the Art, Breath of the claims

Given that the instant claims are drawn to a composition wherein the components are two identical compounds, in short one compound, the scope of the instant claims would be inclusive of an invention wherein any compound or active substance used in a medicinal preparation would be included in the claimed invention. The patentability in composition claims resides in the compound, no matter what method of production is set forth. As such, applicant has made a claim to any compound of therapeutic nature and a carrier as the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant regards as the invention.

In the absence of a structural formula or chemical name, the following terms are seen to render the claims in which they appear indefinite in all occurrences: material carrier, medicinal substance, bioactive substance and medical preparation.

In claims 1-4, applicant recites a medicinal preparation which is produced by homeopathic methods and has initial chemical formula or composition identical with that of the said active substance. It is unclear as to how a compound that has the "identical" chemical formula as the active substance can be differentiated from the active substance and is not the active substance itself as products of identical chemical composition can not have mutually exclusive properties.

In claim 1, it is unclear as to whether applicant intends a process or a composition, as such, applicant should draft the instant claims as proper and conventional composition or process claims. Accordingly, dependent claims 2 and 3 are rejected as they fail to obviate the rejections set forth in the parent claim(s).

Claim 4 recites a method of medicinal action on the "organism". Applicant should set forth in full, clear and concise terms exactly what applicant intends by organism, given that this

term can be broadly applied to a wide array of living species from protozoa and bacteria to human beings.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ecanow, U.S. Patent No. 4,963,367.

Claims 1-3 are drawn to a medicinal preparation which is produced by homeopathic methods and has initial chemical formula or composition identical with that of the said active substance. The patentability in composition claims resides in the compound, no matter what method of production is set forth. As such, applicant has made a claim to any compound of therapeutic nature and a carrier as the invention. Ecanow anticipates these claims as it discloses a medicinal preparation comprising a material

carrier and one or more active compounds dispersed in an aqueous solution (see claim 5 and p.1-3).

ENDING

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Primary Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

March 11, 1999

Howard Owens

Group 1623

JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600